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REMARKS

Claims 1-7, 9-12, and 14-22 are pending in the present application. Claims 1 and 16 have been amended to correct typographic errors and/or to further clarify the subject matter recited therein. No new matter is added by the new claim, which finds support throughout the specification and figures. In view of the amendments and the following remarks, favorable reconsideration of this case is respectfully requested.

Claims 1-7, 9-12, and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,522,769 to Rhoads et al. (hereinafter referred to as Rhoads), in view of European Patent No. 0651554 A1, to Melnychuck et al. (hereinafter referred to as Melnychuck). Applicants respectfully traverse.

Claim 1 relates to a method of providing a content in which, when a content is transmitted to a user, an electronic watermark for preventing execution of the content is embedded in the content and at least information associated with the user, to whom the content is to be transmitted, is added to the content. The method of amended claim 1 also includes, when the content is executed, the information associated with the user who has received the content is *checked at a transmitting end*, and when the content is executed, the information associated with the user who has received the content is *checked at a receiving end*. Furthermore, the execution of the content is allowed by removal of the electronic watermark *if and only if the result of both checking steps indicates that the content is an authorized content*.

The Examiner admits that Rhoads does not disclose removing a watermark as recited in claim 1, and asserts that Melnychuck discloses this feature by describing a digital image being transmitted to a customer with a watermark that prevents high resolution viewing (Melnychuck; col. 4, lines 30-48). In Melnychuck, an authorization is required for removing the watermark

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(Melnychuck; col. 5, lines 36-41), and the customer can obtain the authorization in the form of a decryption key or password obtained from the provider of the digital prints (the "professional"). (Melnychuck; col. 4, lines 30-48 and col. 9, lines 20-40).

However, the Examiner does not provide any motivation to combine the reference other than a restatement of the features of claim 1 (Office Action; page 3, lines 16-21; and page 9, lines 3-6). This motivation does not appear to be based on either of the references, and therefore appears to result from improper hindsight. The conclusory reasoning of the Office Action is insufficient to support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kozab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Federal Circuit addressed the standard for obviousness and the requirement of motivation in Teleflex, Inc. et al. v. KSR Int'l Co., (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, "a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, *but some motivation to combine the prior art*

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teachings in the particular manner claimed." (*Teleflex*, citing *In re Kotzab*; emphasis added).

The Federal Circuit found that that there was no motivation to combine the Asano patent, which disclosed all of the limitations except the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, *the test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.*

(*Teleflex*, citing as background *Rouffer*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in Rhoads to combine its teaching with Melnychuck. Rhoads apparently discloses a "dial tone" signal used (Rhoads; col. 5, lines 60-67), which the Examiner apparently asserts discloses a watermark as claimed. However, the dial-tone signal in Rhoads is low amplitude, relatively wideband, repetitive signal that commonly conveys only limited information (Rhoads; col. 5, lines 60-63). It is difficult to conceive that such a dial tone signal is removed, and therefore the device apparently disclosed in Rhoads teaches away from a combination with Melnychuck.

The Examiner admits that Rhoads does not disclose removing a watermark as recited in claim 1. However, the Examiner asserts that Melnychuck discloses this feature by describing a digital image being transmitted to a customer with a watermark that prevents high resolution viewing. (Melnychuck; col. 4, lines 30-48). In Melnychuck, an authorization is required for removing the watermark (Melnychuck; col. 5, lines 36-41), and the customer can obtain the authorization in the form of a decryption key or password obtained from the provider of the

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digital prints (the "professional") (Melnychuck; col. 4, lines 30-48 and col. 9, lines 20-40). However, the Examiner does not provide any motivation to combine the references other than a restatement of the features of claim 1, stating that "it would have been obvious ... to incorporate the Melnychuck's teaching with Rhoads invention to remove the watermark using the authorization code sent from the server after checking indicates that said content is an authorized content." (Office Action; page 3, lines 12-15). This motivation does not appear to be based on either of the references, and appears to result from improper hindsight. As the Teleflex court held, there must be specific teaching to motivate a person of ordinary skill in the art must to combine the prior art teachings in the particular manner claimed. Therefore it is respectfully submitted that the combination of the references is improper.

Additionally, even if Rhoads is combined with Melnychuck, the propriety of which is hereby respectfully not conceded, the combination of the references does not disclose all of the features of the present invention. The Examiner picks and chooses among the two references to support the disclosure of the feature of unamended claim 1 of:

when said content is executed, said information associated with the user who has received *said content is checked at both transmitting and receiving ends*, and the execution of said content is allowed by removal of said electronic watermark if and only if the result of the checking indicates that said content is an authorized content,

(unamended claim 1, lines 5-8, emphasis added) by asserting that the Rhoads disclosure of verifying watermarked digital content upon execution, and the Melnychuck disclosure of acquiring a key for removing a watermark from a transmitting end prior to execution, can be combined to render claim 1 obvious (Office Action; page 8, line 15, to page 9, line 3). However, neither of the references disclose *the dual checking operations* recited in the claims and therefore the claims are allowable.

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Additionally, in the interest of expediting prosecution, Applicants herein amend claim 1 to clarify the dual checking operation recited therein. In amended claim 1, when said content is executed, *said information* associated with the user who has received said content *is checked at a transmitting end*; and when said content is executed, *said information associated with the user is checked at a receiving end*. Also in amended claim 1, the execution of said content is allowed by removal of said electronic watermark *if and only if the result of both checking steps indicates that said content is an authorized content*.

The Examiner cites Rhoads at column 11, lines 29-47 as disclosing the feature of when content is executed, the information associated with the user who has received the content is checked at both transmitting and receiving ends, and the execution of the content is allowed by removal of the electronic watermark if and only if the result of the checking indicates that the content is an authorized content. However, Rhoads apparently only discloses copy prevention mechanisms such as a file that can only be copied once, or files that can only be copied onto devices owned by the user. Additionally, Rhoads discusses confirmation of device ownership by an *initial registration process* and supplemented by the user when acquiring new devices, and this ownership information would be encoded into the downloaded music. (Rhoads; col. 11, lines 38-42). However, Rhoads does not disclose or suggest *a check at a transmitting end* (for instance, the clearinghouse in Rhoads) *when the content is executed* and before the removal of the electronic watermark. Therefore, neither of Rhoads nor Melnychuck's disclose or suggest the features of claim 1, and therefore the claim is allowable over the combination of the references, the appropriateness of which is respectfully contested.

For these reasons, Applicants respectfully submit that Rhoads fails to anticipate Applicants' claimed invention as claimed in independent claim 1, and that independent claim 1 is

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therefore allowable. As independent claims 2-5, 9, 10, 14 and 15 substantially include the limitations of claim 1 pertaining to watermarks, Applicants further submit that independent claims 2-5, 9, 10, 14 and 15 are not anticipated by Rhoads and are in condition for allowance. In addition as claims 6 and 7 depend from allowable independent claims 4 and 5, Applicants further submit that these claims are allowable for at least this reason. And since claims 11 and 12 depend from allowable independent claims 9 and 10, Applicants further submit that these claims are allowable for at least this reason. In addition as claims 16-18 depend from allowable independent claim 1, claim 19 depends from allowable independent claim 4, and claims 20 and 21 depend from allowable independent claim 14, Applicants further submit that these dependent claims are allowable for at least the same reason as their respective base claims are allowable.

Additionally, claim 16 recites that, *when the result of the checking at the transmitting and receiving ends indicates that said content is an authorized content*. It is submitted that Melnychuck at col. 4, lines 35-45 does not disclose or suggest transmitting to the user key information for removal of said electronic watermark when the result of checking at the transmitting and receiving ends indicates that said content is an authorized content. Melnychuck does not disclose or suggest a dual checking operation, as clearly recited in the amended claim, and therefore, for at least this additional reason claim 16 is allowable.

Similarly, claims 18 and 21 relate to deleting the key information by the user after removal of the electronic watermark. The Office Action admits that neither Rhoads nor Melnychuck disclose or suggest this feature. (Office Action; page 6, lines 10-15). Though the Examiner asserts that it would have been obvious to modify the invention, this misconstrues 35 U.S.C. 103(a), which requires that each and every feature recited in the claims be shown in at least one of the cited references. The obviousness standard may allow the combination of

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references, but it does not permit a rejection based upon a feature not disclosed in either reference. Therefore, for at least this additional reason claims 18 and 21 are allowable.

Claim 22 depends from independent claim 16 and is therefore allowable for at least the same reason as claim 16 is allowable. Additionally, claim 22 recites that the key information for removal of the electronic watermark is transmitted to the user when, first, said information associated with the user who has received said content is checked at the receiving end, and second, a result of the check is communicated by the receiving end to the transmitting end. Finally, in claim 22, as a third step, *the transmitting end checks said information associated with the user*. It is respectfully submitted that neither Rhoads nor Melnychuck disclose or suggest this feature. The rejection of claim 22 is mentioned in sections 5 and 6 of the Office Action, but no particular discussion or citation to either of the references is made with regard to the features of claim 22. The Examiner is reminded that it is the duty of the Examiner to specifically point out each and every limitation of a claim being rejected as per § 1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly states that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified". Since neither Rhoads nor Melnychuck discloses or suggests the checking performed at a user terminal before a content provider transmits to the user terminal the key information, new claim 22 is allowable over the references.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

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Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



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